

REMARKS

In the Final Office Action dated July 23, 2003, the Examiner indicated that the Amendment filed May 15, 2003, was only entered in part. In particular, the Examiner indicated that an amendment to the specification was not entered because the page and line number of the phrases provided in the instructions did not correspond to the specification in the application. Applicants respectfully request that the Examiner refer to page 10, line 20 of the specification, which is the point of insertion of the amendment to the specification contained in the May 15, 2003, Amendment. Applicants submit that the instructions properly correspond to the proper page and requests that the Examiner acknowledge whether the amendment has been entered in the next Office Action.

The Examiner objected to the claim amendments under 35 U.S.C. § 132 because the Examiner alleged they introduced new matter into the disclosure; the Examiner objected to the specification under 35 U.S.C. § 112, first paragraph, as failing to adequately teach certain claim elements; and the Examiner rejected claims 1-33 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. These rejections are respectfully traversed for at least the following reasons.

I. OBJECTION UNDER 35 U.S.C. § 132

Regarding the objection to the claim amendments under 35 U.S.C. § 132, Applicants respectfully remind the Examiner that M.P.E.P. § 2163.06 states, in pertinent part, if new subject matter is added to the disclosure, whether it be in the abstract, the specification, or the drawings, the examiner should object to the introduction of new matter under 35 U.S.C. §§ 132 or 251 as appropriate, and require applicant to cancel

the new matter. However, if new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. § 112, first paragraph's written description requirement. See M.P.E.P. § 2163.06 (8th ed. 2001).

Applicants' response filed May 13, 2003 did not introduce new matter into the disclosure. Instead, the response included amendments to claims 1, 16, 18, 29, 32, and 33 (See Response filed May 13, 2003, p. 2). Accordingly, because the Examiner's objection is directed to amendments to the claims, and not to an amendment of the specification, this objection is improper. For at least this reason, Applicants request that the Examiner withdraw the objection under 35 U.S.C. § 132.

II. OBJECTIONS AND REJECTIONS UNDER 35 U.S.C. 112, ¶1

In objecting to the specification under 35 U.S.C. § 112, first paragraph, the Examiner alleges that Applicants' specification fails to adequately teach certain claim elements. Specifically, the Examiner refers to the recitations "transmit said derived event to one of a plurality of operator workstations via said event notification service, regardless of a significance of said derived event" added to claims 1, 16, 18, 32, and 33, and "transmitting said parsed event to said network management service, regardless of a significance of said parsed event" added to claim 28. Applicants respectfully submit that these recitations are supported by Applicants' originally filed specification.

For example, page 15, lines 3-11 of Applicants' disclosure states in part, "[i]n operation, the event notification service receives an unparsed message or event from the network mediation service and then passes the message to the message parsing service for processing. After the message has been parsed by the message parsing service, it is passed back to the event notification service, which passes the messages

along an event channel to the network management service. The message is also passed to the even correlation service for event correlation.” Additionally, at page 18, lines 13-14, Applicants’ disclosure states, “[o]perator workstations 35 a-c are similarly coupled to separate event channels of network management service 30.”

Furthermore, Applicants respectfully note that the recitations “regardless of a significance of said derived event” and “regardless of a significance of said parsed event,” as recited in claims 1, 16, 18, 32, and 33 are inherently disclosed by the specification and thus do not constitute new matter. Applicants respectfully refer the Examiner to M.P.E.P. § 2163.07(a), which states in relevant part, by disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. See M.P.E.P. § 2163.07(a) (8th ed. 2001), citing *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973). Accordingly, Applicants request the Examiner to withdraw the objection to the specification under 35 U.S.C. § 112, first paragraph.

Moreover, Applicants request that the rejection of claims 1-33 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement be withdrawn for at least the same reasons set forth immediately above. As explained, the recitations cited by the Examiner are supported by Applicants’ originally filed disclosure.

In making the various references to the specification set forth herein, it is to be understood that Applicants are in no way intending to limit the scope of the claims to the exemplary embodiments described in the specification. Rather, Applicants expressly affirm their right to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation and applicable case law.

III. REJECTIONS UNDER 35 U.S.C. § 102(b)

The Examiner rejected claims 16, 17, and 32 under 35 U.S.C. § 102(b) as being anticipated by Jacobs (U.S. Patent No. 5,761,502). Applicants respectfully traverse the rejection.

In order to properly anticipate Applicants' claimed invention under 35 U.S.C. § 102(b), each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2121 (8th ed., Aug. 2001), *quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th ed. 2001), p. 2100-69.

Jacobs discloses a system and method for managing telecommunications networks. In particular, Jacobs discloses using a state filter to determine whether a state change of a transmission segment is significant enough to report. See col. 12, lines 8-10. In that regard, Jacobs discloses that when the state filter determines that the state change is not significant, the process ends. When the state filter determines that

state change is significant, the process proceeds and sends a notification message of the state change. See col. 12, lines 22-27.

By contrast, claim 16 recites a combination including, among other things, “transmitting said derived event to one of a plurality of operator workstations, regardless of a significance of a derived event.” Jacobs does not disclose at least this feature of claim 16 and thus does not anticipate the claim.

In the Response to Arguments section of the Final Office Action on page 15, the Examiner alleges that the “derived event” recited in claim 16 is anticipated by Jacobs at col. 9, lines 38-62. Applicants respectfully disagree. The cited portion of Jacobs discloses that presentation manager 216 receives data from expert system 326 and from databases 316-320. The received data, however, is then formatted by presentation manager 216. See col. 9, lines 43-46. Jacobs thus discloses receiving data and then formatting it, which does not anticipate at least “transmitting said derived event to one of a plurality of operator workstations, regardless of a significance of a derived event,” as recited in claim 16. Accordingly, the Examiner should withdraw the rejection of claim 16.

Claim 32 includes recitations similar in scope to those of claim 16 and is thus allowable for at least the same reasons discussed above. Claim 17 depends from claim 16. Accordingly, claim 17 is deemed allowable for at least the same reasons set forth above in connection with base claim 16.

IV. REJECTIONS UNDER 35 U.S.C. § 103(a)

The Examiner rejected claims 1-7, 18, 18, 19, 22, 25, 28, 29, and 33 under 35 U.S.C. § 103(a) as being unpatentable over Jacobs in view of Lawson et al. (U.S. Patent No. 5,721,825). Applicants respectfully traverse the rejection.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of the following three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

As discussed above, Jacobs discloses a system and method for managing telecommunications networks. Lawson discloses a system and method for global even notification in a distributed computer environment. As disclosed by Lawson, the system and method allows local event consumers to register for notification of an event and then sends notification of events that occur to registered local event consumers. See col. 4, lines 33-36.

By contrast, claims 1, 18, and 33 recite a combination including, among other things, transmitting "said derived event to one of a plurality of operator workstations via said event notification service, regardless of a significance of said derived event." Claim

28 recites a combination including, among other things, “transmitting said parsed event to said network management service, regardless of a significance of said parsed event.” Neither Jacobs nor Lawson, taken alone or in combination, disclose or suggest at least these features of claims 1, 18, 28, and 33.

Moreover, there is no suggestion or motivation to combine these references. The Examiner alleges because “both Jacobs and Lawson teaches event distribution across a network, it would have been obvious the invention of Jacobs would also include network mediation service in order for the network elements to communicate across different network domains” (Final Office Action, page 7). Applicants respectfully submit that such an allegation by the Examiner does not establish a proper motivation for combining Jacobs and Lawson as required by M.P.E.P. § 2143. For example, Jacobs does not suggest nor disclose including a “network mediation service” for more effective communication, as suggested by the Examiner. Lawson fails to remedy these deficiencies of Jacobs. Accordingly, neither reference explicitly or implicitly provides a valid motivation for combining the references to suggest the recitations of claims 1, 18, 28, and 33.

In addition, the Examiner has not demonstrated a reasonable expectation of success for making the proposed combination. Accordingly, for at least the above reasons, the Examiner should withdraw the rejection of claims 1, 18, 28, and 33. The Examiner should also withdraw the rejection of dependent claims 2-7, 19, 22, and 29 because these additional claims include allowable subject matter as recited in their respective independent claims.

The Examiner also rejected claims 8-15, 20, 21, 23, 24, 26, 27, 30, and 31 under 35 U.S.C. § 103(a) as being unpatentable over Jacobs and Lawson in view of Cohen et al. (U.S. Patent No. 6,477,585). Applicants respectfully traverse the rejection.

As discussed above, Jacobs and Lawson do not teach or suggest at least transmitting "said derived event to one of a plurality of operator workstations via said event notification service, regardless of a significance of said derived event," as recited in claims 1, 18, and 33. Nor do Jacobs and Lawson disclose or suggest at least "transmitting said parsed event to said network management service, regardless of a significance of said parsed event," as recited in claim 28.

Moreover, Cohen does not make up for the deficiencies of Jacobs and Lawson. Cohen discloses an event management service used in a districted computing environment that includes a filter mechanism for determining whether events generated by one or more even supplies are communicated to one or more even consumers. Accordingly, neither Jacobs, Lawson, and Cohen disclose or suggest the exemplary recitations of claims 1, 18, 28, and 33, as discussed above.

Claims 8-15, 20, 21, 23, 24, 26, 27, 30, and 31 depend directly or indirectly from claims 1, 18, and 28. Consequently, for at least the same reasons set for above for claims 1, 18, and 28, claims 8-15, 20, 21, 23, 24, 26, 27, 30, and 31 are patentable under 35 U.S.C. § 103(a) over Jacobs, Lawson, and Cohen.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

PATENT
EXPEDITED PROCEDURE REQUESTED UNDER 37 CFR § 1.116
USSN 09/577,071

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 07-2339.

Respectfully submitted,

Dated: 10/21/2003

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